| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/749,439 | 12/31/2003 | David Marmaros | 24207-10098 | 8961 |

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| EXAMINER |
|---|
| SMITH, CHENECA |

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| 2192 | |

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|---|---|
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
| :--- | :--- | :--- |
| **Office Action Summary** | 10/749,439 | MARMAROS ET AL. |
| | Examiner | Art Unit | |
| | Cheneca P. Smith | 2192 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on <u>31 December 2003</u>.

2a) ☐ This action is **FINAL**.    2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) <u>1-18</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-18</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>31 December 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　　1. ☐ Certified copies of the priority documents have been received.

　　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/20/2004</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

1.      This action is in response to the application filed on December 31, 2003.

2.      Claims 1-18 have been examined.

### *Specification*

3.      The attempt to incorporate subject matter into this application by reference
to the co-pending US patent application entitled Methods and Systems for
Regulating Resource Usage is ineffective because the serial number of the co-
pending application is incomplete and should be properly updated (see page 13,
paragraph [0047] of the specification).

4.      The incorporation by reference will not be effective until correction is made
to comply with 37 CFR 1.57(b), (c), or (d).  If the incorporated material is relied
upon to meet any outstanding objection, rejection, or other requirement imposed
by the Office, the correction must be made within any time period set by the
Office for responding to the objection, rejection, or other requirement for the
incorporation to be effective.  Compliance will not be held in abeyance with
respect to responding to the objection, rejection, or other requirement for the
incorporation to be effective.  In no case may the correction be made later than
the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the
application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated
by reference must be accompanied by a statement that the material being

inserted is the material incorporated by reference and the amendment contains

no new matter.  37 CFR 1.57(f).


### *Claim Rejections - 35 USC § 101*

5.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

Claims 11-18 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.  Claim 11 recites a

"computer-readable medium". It appears that the computer-readable media is

intended to include wireless media, which is a signal (see page 15, paragraph

[0053], lines 15-17).  A product is a tangible physical article or object, some form

of matter, which a signal is not. A signal, a form of energy, does not fall within

one of the four statutory classes of § 101. As such, the claimed "computer-

readable medium" is not limited to embodiments that fall within a statutory

category of invention (see Interim Guidelines for Examination of Patent

Applications for Patent Subject Matter Eligibility – Annex IV(c) (1300 OG 142

signed 26Oct2005). Consequently, claim 11 is rejected as non-statutory.

Claims 12-18 mirror the deficiencies of claim 17 and are also rejected as

non-statutory.

## Claim Rejections - 35 USC § 102

6.      The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.      Claims 1-3, 11 and 12 are rejected under 35 U.S.C. 102(e) as being

anticipated by Moshir et al (US Patent 6,990,660 B2).

As to claim 1, Moshir teaches a method of the present invention for

installing a software component on a computing device comprising:

monitoring usage of the computing device (see FIG.6, 604 and associate text,

e.g. col. 19 lines 61-65),

determining a need for a software component (see col. 13 lines 39-46) and

initiating installation of the software component during a time period based on the

activity level of the computing device (see FIG. 3, 312, attempt second download

and associated text, e.g. col. 10, lines 7-18).

As to claim 2, Moshir teaches the method of claim 1 wherein the

monitoring usage of the computing device comprises one or more of the

following: monitoring user activity (see FIG. 3, 312, attempt second download

and associated text, e.g. col. 10, lines 7-18), monitoring usage of a processor

(see col. 19 lines 62-63), and/or monitoring usage of a network (see FIG.6: 610,

614, 618 and associated text e.g. col. 14 lines 13-20).

As to claim 3, Moshir teaches the method of claim 2 wherein the

monitoring usage of the computing device comprises monitoring usage of the

processor (see col. 19 lines 62-63) and the method comprises initiating

installation of the software component during a time period based on the activity

level of the processor (see FIG. 3, 312, attempt second download and associated

text, e.g. col. 10, lines 7-18).

As to claim 11, Moshir teaches a computer-readable medium on which is

encoded program code, the program code comprising:

program code for monitoring usage of a component of a computing device (see

FIG.6, 604 and associate text, e.g. col. 19 lines 61-65)

program code for determining a need for a software component on the computing

device (see col. 13 lines 39-46)

and program code initiating installation of the software component during a time

period based on the activity level of the component of the computing device (see

FIG. 3, 312, attempt second download and associated text, e.g. col. 10, lines 7-

18).

As to claim 12, Moshir teaches the computer readable medium of claim 11

wherein the component of the computing device comprises one or more of the

following: user activity, a processor and/or a network (see FIG.6 and associated

text e.g. col. 14 lines 13-20).

### *Claim Rejections - 35 USC § 103*

8.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

9.      Claims 4-10 and 13-18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Moshir et al (US Patent 6,990,660 B2) in view of Ly (US

Patent 6,971,094 B1).

As to claim 4, Moshir teaches the method of claim 3 wherein the

computing device is a recipient computing device on a network (see FIG.2:

202,208 and associated text e.g. col. 3 lines 44-48) connected to a donor

computing device comprising files for installation (see FIG.2: 230,234 and

associated text e.g. col. 3 lines 44-48), but does not specifically teach that and

the method comprises monitoring usage of the network connection and initiating

transfer of files from the donor computing device to the recipient computing

device during a time period based on the level of network activity. In an

analogous art, however, Ly is cited to teach monitoring usage of the network

connection (see column 1 lines 43-47) and initiating transfer of files from the

donor computing device to the recipient computing device during a time period

based on the level of network activity (column 1 lines 52-54). It would have been

obvious to one having ordinary skill in the art at the time the invention was made

to combine the teachings of Moshir and Ly to simplify the maintenance of

applications distributed on many different computer systems from a central

location, as disclosed by Ly (see column 1 lines 59-61).

As to claim 5, Moshir also teaches the method of claim 4 wherein the

donor-computing device comprises a remote server (see FIG.2, 220 and

associated text).

As to claim 6, Moshir also teaches the method of claim 5 further

comprising monitoring the transfer process, and reducing the activity level of the

transfer process based on the level of other activity on the network connection

(see col. 10 lines 14-18).

As to claim 7, Moshir also teaches the method of claim 6 wherein the

transfer process is halted (see col. 10 lines 1-4).

As to claim 8, Moshir also teaches the method of claim 7 further

comprising resuming the transfer and continuing the transfer until a complete file

for installation has been transferred to the recipient computing device (see col.

10 lines 4-12, lines 19-21 and lines 32-33).

As to claim 9, Moshir also teaches the method of claim 5 further

comprising installing the installation files on the recipient computing device (see

col. 10 lines 19-21 and lines 32-33).

As to claim 10, Moshir also teaches the method of claim 8 wherein the

installing comprises monitoring usage of the processor (see Moshir: col. 19 lines

62-63), and installing based on the activity level of the processor (see FIG. 3,

312, attempt second download and associated text, e.g. col. 10, lines 7-18).

As to claim 13, Moshir teaches the limitations of claim 12, wherein the

computing device is networked (see FIG.1 and associated text) but does not

specifically teach that the medium further comprises program code for monitoring

network activity and program code for initiating installation of the software

component based on the level of network activity. In an analogous art, however,

Ly is cited to teach program code for monitoring network activity (see col. 1 lines

43-47) and program code for initiating installation of the software component

based on the level of network activity (see col.1 lines 52-54). It would have been

obvious to one having ordinary skill in the art at the time the invention was made

to combine the teachings of Moshir and Ly to simplify the maintenance of

applications distributed on many different computer systems from a central

location, as disclosed by Ly (see col. 1 lines 59-61).

As to claim 14, Moshir also teaches the computer-readable medium of

claim 12 wherein the program code for initiating installation comprises program

code for downloading the update from a remote server (see col. 10 lines 7-10).

As to claim 15, Ly further teaches the computer-readable medium of claim

14 further comprising program code for monitoring the downloading process and

code for reducing the level of activity of the downloading process based on the

level of network activity (see col. 1 lines 44-50).

As to claim 16, Moshir also teaches the computer-readable medium of

claim 15 further comprising program code for resuming the download and

continuing the download until a complete installation file has been obtained (see

col. 10 lines 4-12, lines 19-21 and lines 32-33).

As to claim 17, Moshir also teaches the computer-readable medium of claim 15 further comprising program code for installing the installation file (see col. 10 lines 19-21 and lines 32-33).

As to claim 18, Moshir also teaches the computer-readable medium of claim 17 wherein the program code for installing comprises program code for monitoring usage of the processor (see col. 19 lines 62-63) and computer program code for installing based on the activity level of the processor (see FIG. 3, 312, attempt second download and associated text, e.g. col. 10, lines 7-18).

## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheneca P. Smith whose telephone number is (571) 270-1651. The examiner can normally be reached on Monday-Friday 7:00-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

CS
9/10/2007

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